

REMARKS

Claims 1-19, as amended, and new claim 20 are currently pending. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1, 13, and 16 have been rewritten to further clarify the embodiments of the present invention recited therein. Various dependent claims have been rewritten or canceled to maintain consistency with the language now recited in the independent claims. Furthermore, claim 20 has been added to recited embodiments fully supported by the Written Description. As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

THE REJECTIONS UNDER 35 U.S.C. §§ 102 & 103

Claims 13 and 16 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,620,363 to Farris *et al.* for the reasons provided on page 2 of the Office Action. In addition, claims 1-12 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,139,447 to Ohama in view of Farris as set forth on pages 2-4 of the Office Action. Furthermore, the Examiner rejected claims 17-19 under § 103(a) as being obvious over Farris in view of Ohama for the reasons stated on pages 4-5 of the Office Action. Neither Farris nor Ohama teach or suggest the present invention for at least the reasons that follow.

Farris Does Not Anticipate Claims 13 and 16

Farris generally discloses a method for recycling thermoset materials that involves the use of powdered thermoset materials and lubricants or volatile solvents under moderate temperature and pressure. *See Abstract.* In particular, the Farris method requires the addition of aromatic oil, paraffinic oil, a volatile solvent, or a combination thereof to a thermoset material. Col. 2, lines 22-31. Once lubricated, the material is pressurized to up to 10,000 psi and heated to a temperature between about 100°C and the decomposition temperature of rubber, *e.g.*, 100°C to 250°C. Col. 2, lines 41-50.

In contrast, the invention recited in independent claims 13 and 16 features a method of forming one or more golf ball layers that include pre-vulcanized or pre-crosslinked

materials. In particular, this claim uses “consisting essentially of” transition language that excludes any materials that materially affect the composition. The Farris reference includes instruction to use a lubricant and further teaches that the step of adding the lubricant makes up for the loss of oil extenders when the rubber is ground. Col. 2, lines 24-25 and Col. 7, lines 31-37.

Furthermore, with regard to claim 16, the claim now recites a particle size of the pre-vulcanized or pre-crosslinked materials of about 5 μm to about 10,000 μm . In contrast, Farris does not teach finely ground particles for use in the method disclosed therein. In fact, Farris teaches that any particles can be used for the process, but that it is preferred to use crumb materials. Col. 4, lines 39-42. As known to those of ordinary skill in the art, even if crumb particles were used with the Farris method, these would not meet the particle size now recited. As further evidence of the difference in particle size between Farris and the present invention, Applicants respectfully direct the Examiner to the examples spanning Column 7 to Column 9. For example, if a skilled artisan were to base particle size on the “particle distribution” discussed in the Farris examples, the smallest particle size would be 40,000 μm (40 mm), which is four times the largest particle size presently recited.

As such, Farris does not teach or suggest such a method for forming a golf ball layer that consists essentially of the recited materials. Furthermore, a skilled artisan would not have been motivated to form a golf ball layer including the recited materials, *sans* lubricant, based on the Farris disclosure, without the instant claims to use a template from which to pick and choose.

Based on the discussion above, Applicants respectfully submit that Farris does not disclose or suggest the present invention. Thus, Applicants respectfully request reconsideration and withdrawal of the § 102 rejection based thereon.

*The Combination of Ohama and Farris Does Not Anticipate
or Render Obvious the Present Invention*

As discussed above, Farris is deficient with respect to the presently recited invention. In particular, Farris does not disclose or suggest a golf ball layer consisting essentially of the claimed materials in claims 13 and 16, nor does the reference teach or suggest the presently recited particle size of the materials in claim 16. Furthermore, Farris does not teach or suggest the amount of pre-vulcanized or pre-crosslinked materials now recited in claim 1. In fact, Farris merely discloses a ratio of rubber powder to lubricant (see, *e.g.*, Col. 7, lines 60-

64), but does not discuss the amount of rubber powder based on any amount of a base rubber material.

And, while Ohama does disclose the amount of vulcanized rubber powder, the amount is less than presently recited. Col. 4, lines 35. Ohama even teaches away from the presently recited amount of pre-vulcanized or pre-crosslinked material at Col. 4, lines 32-36. Based on this instruction, Ohama cannot remedy Farris' deficiencies with respect to claims 1, 13, and 16.

For the reasons above, Applicants respectfully submit that the combination of Farris and Ohama does not disclose or suggest the present invention. Thus, Applicants respectfully request reconsideration and withdrawal of the § 103 rejections based on the combination of Farris and Ohama.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response two months to and including March 6, 2006 since the due date of March 5, 2006 falls on a Sunday. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20002.0319.

Respectfully submitted,
BINGHAM MCCUTCHEN LLP

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By: Stephanie D. Scruggs
Stephanie D. Scruggs, Registration No. 54,432
BINGHAM MCCUTCHEN LLP
3000 K Street, NW, Suite 300
Washington, D.C. 20007
(202) 424-7755 Telephone
(202) 295-8478 Facsimile